

Application No.: 09/719893

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**Remarks**

Claims 1 to 20 are pending. Claims 1, 8, 12, 13, 15, and 16 have been amended. Claim 21 has been added. Claim 10 has been canceled.

Support for the amendment to claim 1 reciting a substrate having a thickness from 1 to 7  $\mu\text{m}$  is found in the specification as filed, e.g., on page 12, lines 5-6 and lines 25-28; page 19, lines 14-15; and page 20, lines 2-3, and lines 27-30. Support for the amendment to claim 1 replacing the phrase "characterized in that said" with the phrase "wherein the" can be found in the specification as filed, e.g., page 5, lines 25-29.

The amendment to claim 8 was made to correct a minor typographical error. Support for the amendment can be found in the specification as filed at page 8, lines 8-11.

Support for new claim 21 can be found in the specification as filed, e.g., claim 10; page 14, lines 6-15; and page 13, lines 15-19.

Claims 12, 13, 15, and 16 have been amended to depend from new claim 21. Support for these amendments can be found in claims 10, 12, 13, 15, and 16; page 14, lines 6-15; and page 13, lines 15-19.

Please cancel claim 10.

**§ 102 Rejections**

Claims 1-2, 4-7, 11, and 18 stand rejected under 35 USC § 102(b) as purportedly being anticipated by Bujard (US 5,399,416).

As amended, claim 1 requires a substrate having a thickness of 1 to 7  $\mu\text{m}$ . This amendment is supported in the specification as filed, where various species within the range of 1 to 7  $\mu\text{m}$  are described, and where the instant specification describes the thickness of substrates as "preferably as small as possible." (See, e.g., page 12, lines 4-5, and lines 25-27.) The Patent Office acknowledged that Bujard does not indicate substrates having thicknesses of 1-7  $\mu\text{m}$ , and that Applicants' claimed heat conductive sheet having a substrate of 1-7  $\mu\text{m}$  would be novel and unobvious over the prior art. (See, Paper No. 13, paragraph 18.)

For at least this reason, the rejection of claim 1 under 35 USC § 102(a) as purportedly being unpatentable over Bujard has been overcome and should be withdrawn. Claims 2, 4-7, 11 and 18

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each depend from claim 1 and add further limitations thereto. Claim 1 is patentable for at least the reasons stated above; thus, claims 2, 4-7, 11, and 18 are likewise patentable.

In summary, the rejection of claims 1-2, 4-7, 11, and 18 under 35 USC § 102(b) as purportedly being anticipated by Bujard (US 5,399,416) has been overcome and should be withdrawn.

### **§ 103 Rejections**

Claim 9 stands rejected under 35 USC § 103(a) as purportedly being unpatentable over Bujard.

Claim 9 depends from claim 1 and adds further limitations thereto. Claim 1 is patentable over Bujard for at least the reasons stated above. Thus, claim 9 is likewise patentable.

In addition, although Bujard describes the possibility of using mixtures of fillers (see, col. 2, lines 51-57), Bujard does not describe, teach or suggest specific mixtures of fillers, e.g., silicon carbide and boron nitride as required in claim 9. Also, the Patent Office has not shown that Bujard provides any motivation to select this specific combination of fillers.

For at least these reasons, the rejection of claim 9 under 35 USC § 103(a) as purportedly being unpatentable over Bujard is unwarranted and should be withdrawn.

Claims 10 and 12-17 stand rejected under 35 USC § 103(a) as purportedly being unpatentable over Bujard in view of DuPont (WO 99/59031).

Claim 10 has been canceled. New claim 21, which is similar to claim 10, clarifies that the present invention requires that the second surface of the substrate be releasably bonded to the support. The Patent Office acknowledged that Bujard does not teach supporting the substrate or removing the substrate from the support after coating. (See, Paper No. 13, paragraph 11.) At best, DuPont describes taping the leading edge of the substrate to the support. (See, page 11, lines 36-37, emphasis added.) Applicants respectfully submit, that releasably bonding the second surface of the substrate to the support is distinct from taping the leading edge of the substrate to the support. (See, e.g., Comparative Example 3, wherein the sample could not be prepared because the substrate was not laminated to the support.)

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For at least this reason, Applicants' submit that new claim 21 is patentable over Bujard in view of DuPont. As amended, claims 12-17 each depend, directly or indirectly, from claim 21, and add further limitations thereto. Claim 21 is patentable for at least the reasons stated above; thus, claims 12-17 likewise patentable.

In summary, Applicants submit that claims 21 and 12-17 are patentable over Bujard in view of DuPont.

Applicants note that claim 10, as originally filed, was previously rejected under 35 USC 103(a) as being unpatentable over Parker-Hannifin Corporation (PHC) (WO 99/05722) in view of Matsushita Denki (MD) (JP 11033456 A) (see, e.g., Paper No. 4, paragraph 21); and Nishizawa (US 7,741,579) in view of MD (see, e.g., Paper No. 4, paragraph 23). Applicants further note that the Patent Office acknowledged that neither PHC nor Nishizawa teach the specific steps of supporting the substrate, coating the substrate, and removing the substrate from the support. (See, Paper No. 4, paragraphs 22 and 24, respectively.) Relying upon the Abstract, Applicants submit that MD describes tape at the sides to remove the substrate from the support. Thus, MD does not describe, teach or suggest releasably bonding the second surface of the substrate to the support, as required by the present invention.

For at least this reason, Applicants respectfully submit that new claim 21 is patentable over both Parker-Hannifin Corporation in view of Matsushita Denki and Nishizawa in view of Matsushita Denki.

Claim 8 stands rejected under 35 USC § 103(a) as purportedly being unpatentable over Bujard in view of Eddy et al. (US 6,159,588).

Claim 8 depends from claim 1 and adds further limitations thereto. As stated above, Bujard does not describe, teach or suggest substrates having a thickness within the range required by claim 1, as amended. Applicants submit that the proposed combination with Eddy fails to overcome at least this deficiency in Bujard. Thus, the combination does not describe, teach or suggest all of the limitations of claim 8.

For at least these reasons, the rejection of claim 8 under 35 USC § 103(a) as purportedly being unpatentable over Bujard in view of Eddy et al. has been overcome and should be withdrawn.

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Claim 3 stands rejected under 35 USC § 103(a) as purportedly being unpatentable over Bujard in view of Kawate et al. (US 6,159,588) as evidenced by East et al. and Lieberman.

Claim 3 depends from claim 1 and adds further limitations thereto. As stated above, Bujard does not describe, teach or suggest substrates having a thickness within the range required by claim 1, as amended. Applicants submit that the proposed combination with Kawate, East, and Lieberman fails to overcome at least this deficiency in Bujard. Thus, the combination does not describe, teach or suggest all of the limitations of claim 8.

For at least these reasons, the rejection of claim 3 under 35 USC § 103(a) as being unpatentable over Bujard in view of Kawate et al. as evidenced by East et al. and Lieberman has been overcome and should be withdrawn.

Applicants gratefully acknowledge the Patent Office's statement that claims 19 and 20 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants prefer not to amend claims 19 and 20 at this time, pending determination of the patentability of the remaining claims.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of all pending claims, as amended, at an early date is solicited.

The Examiner is encouraged to contact the Applicants agent at the number below to address any questions that remain.

Respectfully submitted,

26 Sept 2003  
Date

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